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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,940	08/28/2003	Steven L. Carey	WR-616	1939
33464	7590	11/23/2004	EXAMINER	
WHITE RODGERS DIV. EMERSON ELECTRIC CO. 9797 REAVIS RD. ST. LOUIS, MO 63123			VORTMAN, ANATOLY	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 11/23/2004 . .

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/604,940

**Applicant(s)**

CAREY, STEVEN L.

**Examiner**

Anatoly Vortman

**Art Unit**

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A

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Amendment***

1. The submission of the amendment filed on 10/15/04 is acknowledged. Claims 1, 3, 4, 6, 7, 9, and 10-12 have been amended. Claims 1-13 are pending in the instant application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 3, 4, 6, 7, and 9-11 recite limitations: "the switching means" or "the second switching means". There is insufficient antecedent basis for these limitations in the claims, since "a temperature-actuated switch" or "a second temperature actuated switch" have been originally positively set forth in the claims.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-11 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by US/5,107,918 to McFarlane et al., (McFarlane).

Regarding claim 1, McFarlane disclosed (Fig. 2-6) an apparatus (34) adapted to be connected to a thermostat sub-base assembly (36) in connection with an HVAC system, the apparatus comprising: a connector (50) configured to be releasably connectable to the sub-base assembly (36), and a temperature-actuated switching means (140, 144, 146, 154, 156) for mechanically switching power (via mechanical relays (122, 136)) supplied from a first connection (Rh) on the sub-base (36) to a second connection (W) on the sub-base (36) so as to enable heating operation of the HVAC system when the switching means (144) is exposed to an ambient temperature below a predetermined temperature.

Regarding claim 4, McFarlane disclosed (Fig. 2-6) an apparatus (34) adapted to be connected to a thermostat sub-base assembly (36) having a plurality of connector pins (42) in connection with an HVAC system, the apparatus (34) comprising: a connector (50) configured to be releasably connectable to the connector pins (42) on the sub-base assembly (36), and a temperature-actuated switching means (140, 144, 146, 154, 156) for mechanically switching power (via mechanical relays (122, 136)) supplied from a first connector pin on the sub-base (36) to a second connector pin on the sub-base (36) so as to enable heating operation of the HVAC system when the switching means (144) is exposed to an ambient temperature below a predetermined temperature.

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Regarding claim 7, McFarlane disclosed (Fig. 2-6) an apparatus (34) adapted to be connected to a thermostat sub-base assembly (36) associated with a plurality of terminals for connecting to an HVAC system, the apparatus (34) comprising: a connector (50) configured to be releasably connectable to the connector pins (42) on the sub-base assembly (36), and a temperature-actuated switching means (140, 144, 146, 154, 156) for mechanically switching power (via mechanical relays (122, 136)) supplied from a first connector pin on the sub-base (36) to a second connector pin on the sub-base (36) so as to enable heating operation of the HVAC system when the switching means (144) is exposed to an ambient temperature below a non-adjustable predetermined temperature.

Regarding claim 2, 5, 8, and 10, McFarlane disclosed (Fig. 2-6) an apparatus (34) in combination with a thermostat sub-base assembly (36) having a plurality of connector pins (42) associated with a plurality of terminals for connecting to an HVAC system, the apparatus comprising: a connector (50) configured to be releasably connectable to the connector pins (42) on the sub-base assembly (36), a temperature-actuated switching means (140, 144, 146, 154, 156) for mechanically switching power (via mechanical relays (122, 136)) supplied from a first connector pin on the sub-base (36) to a second connector pin on the sub-base (36) so as to enable heating operation of the HVAC system when the switching means (144) is exposed to an ambient temperature below a non-adjustable predetermined temperature; and a housing (38) that covers the connector (50) and connection pins (42) of the sub-base assembly (36) so as to prevent damage or entry of unwanted materials.

Regarding claims 3, 6, 9, and 11, McFarlane disclosed (Fig. 5, 6) a second temperature actuated switching means (140, 144, 146, 154, 158) for mechanically switching power (via

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mechanical relays (122, 124, 136), supplied from a third connection (Rc) on the sub-base (36) to a fourth connection (Y) and fifth connection (Y<sub>2</sub>) on the sub-base (36) so as to enable cooling operation of HVAC system when the second switching means (140, 144, 146, 154, 158) is exposed to an ambient temperature above a second predetermined temperature.

Regarding claim 13, McFarlane disclosed (Fig. 2, 4) that the sub-base (36) comprises eight connector pins (42) and the connector (50) is a socket connector configured to be releasably connectable to the eight connector pins (42).

Regarding the new functional limitations: "switch that actuates independent of any electrical power", which have been introduced into claims 1, 3, 4, 6, 7, and 9-11, the limitations have not been given patentable weight because they are narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, or must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279. In the instant case, the aforementioned claims are lacking any structure, which would support the new functional language.

### ***Response to Arguments***

6. Applicant's arguments, filed on 10/15/04, with respect to 35 USC 112, first paragraph rejection of claim 12 have been fully considered and are persuasive. The rejection has been withdrawn.

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The remaining Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 571-272-2047. The examiner can normally be reached on Monday-Friday, between 10:00 am and 6:30 pm..



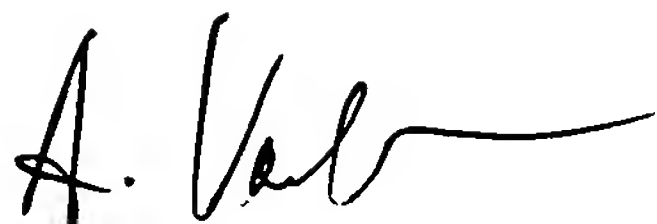
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Lynn Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anatoly Vortman  
Primary Examiner  
Art Unit 2835

AV

A handwritten signature in black ink, appearing to read 'A. Vortman', with a long horizontal flourish extending to the right.